

REMARKS

By this amendment, Applicant has amended claims 1, 5, 11, 13-20 and 23. As a result, claims 1-24 remain pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicant does not acquiesce in the correctness of the objections and rejections and reserves the right to pursue the full scope of the subject matter of the original claims in a subsequent patent application that claims priority to the instant application. Reconsideration in view of the following remarks is respectfully requested.

Initially, Applicant thanks the Examiner and the Examiner's supervisor for their time and courtesy extended during a telephone interview conducted on July 17, 2006 with Applicant's undersigned representative. During the telephone interview, the rejections of claims 1, 11, and 19 were discussed. No agreement was reached as a result of the interview and no exhibits were presented. The substance of the interview is included in the following remarks.

In the Office Action, the Office rejects claims 1, 6, 11, and 14 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,196,447 (Purcell). Applicant respectfully submits that the Office fails to present a *prima facie* showing that Purcell discloses each and every feature of the claimed invention as required by 35 U.S.C. § 102(e). As a result, Applicant respectfully requests withdrawal of this rejection.

For example, as discussed in the telephone interview with respect to claim 1, the Office fails to show that Purcell discloses, *inter alia*, a third party payment system. In particular, the presence of a coupon on an envelope fails to disclose any payment by a third party. To this extent, Applicant has amended claim 1 to further clarify the system. In amended claim 1, the first redeemable instrument is redeemable by a customer for a first redeemable value that is

creditable to the customer by a vendor. Additionally, the second redeemable instrument is redeemable by the vendor and includes a second redeemable value payable to the vendor by a third party. As a result, Applicant respectfully requests withdrawal of the rejection of claim 1 and claim 6, which depends therefrom, as allegedly being anticipated by Purcell.

With respect to claim 11, as discussed in the telephone interview, the Office fails to show that Purcell discloses, *inter alia*, a gift certificate printed on an exterior side of a sealed envelope having an enclosed negotiable instrument (as amended). In support of its rejection, the Office alleges that “Purcell discloses that payments are often enclosed in the envelope, said payment being a second instrument (i.e. check) with a second redeemable value (i.e. value of the invoice or bill).” Office Action, page 2. However, the envelope in Purcell comprises “an envelope for first mailing”. Purcell, col. 1, line 35. As such, the mailing does not include a check, but rather includes an order form or bill. Purcell, col. 1, lines 13-15. Purcell also discusses a return envelope for such mailings. Purcell, col. 1, lines 12-24. However, when in use, the bangtail flap of these envelopes is detached. Purcell, col. 1, lines 22-24. To this extent, Purcell fails to disclose the claimed gift certificate printed on an exterior side of a sealed envelope having an enclosed negotiable instrument. As a result, Applicant respectfully requests withdrawal of the rejection of claim 11 and claim 14, which depends therefrom, as allegedly being anticipated by Purcell.

Further, the Office rejects claims 2-5, 7, 10, 12-13, 15, and 18-24 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Purcell. In order to establish a *prima facie* case of obviousness, the Office must show that (1) every feature is taught or suggested by Purcell; (2) Purcell, or generally available knowledge suggests or motivates the modification(s); and (3) one

would have a reasonable expectation of success. MPEP 2143. Because the Office fails to establish a *prima facie* case of obviousness, Applicant respectfully requests withdrawal of the rejections of claims 2-5, 7, 10, 12-13, 15, and 18-24 for the following reasons.

Initially, with respect to claims 2-5, 7, 10, 12-13, 15, and 18, Applicant incorporates the various arguments presented above with respect to claims 1 and 11, from one of which each of these claims depends. To this extent, Applicant respectfully submits that the Office fails to show that Purcell teaches or suggests every feature of the claimed invention. As a result, Applicant respectfully requests withdrawal of the rejections of claims 2-5, 7, 10, 12-13, 15, and 18 as allegedly being unpatentable over Purcell.

With respect to claims 2-5, 7, 10, 12-13, 15, and 18-24, Applicant notes that in each of the rejections, the Office takes “official notice” of one or more of the claimed features. Applicant notes that “‘official notice’ unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” MPEP 2144.03. Applicant respectfully submits that several instances of the “official notice” taken by the Office are clearly in error and are not common knowledge or well-known in the art. To this extent, Applicant respectfully requests that the Office produce some authority for its “official notice” in several instances. For example, as discussed during the telephone interview, for the facts known by personal experience of the Examiner, Applicant respectfully requests that the Examiner provide an affidavit detailing these facts. However, Applicant does not acquiesce to the appropriateness of the “official notice” for those instances not expressly discussed herein for brevity.

For example, with respect to claim 3, the Office takes official notice of the claimed feature that the second redeemable instrument comprises a bank check. In particular, the Office alleges that “the instrument disclosed may be included in a first mailed envelope for commercial activities... It was well known... for people to enclose a bank check with a specific amount... and therefore it would have been obvious to anyone skilled in the ordinary art to conclude that said second instrument could be a bank check.” Office Action, page 4. However, as discussed above with respect to claim 11, Applicant submits that the first mailing discussed in Purcell comprises the mailing of an invoice, order form, or the like, as part of the commercial activity. As is well known, such a mailing does not include any type of payment, but rather includes a return envelope in which the payment is mailed. As such, the bank check discussed by the Office is not well-known to be included in the first mailing. To the contrary, such a bank check would be included in a second mailing that uses the return envelope. It is not well known for the return envelope to include a gift certificate printed on an exterior side. As a result, Applicant respectfully requests withdrawal of the rejection of claim 3 as allegedly being obvious in view of Purcell. In the alternative, Applicant respectfully requests that the Office produce some authority for its “official notice”.

With respect to claims 5 and 13, the Office takes official notice that “it would have been obvious for the bank check to be valid only for that participating merchant since the gift certificate or coupon attached would be for a discount associated with the merchant for which the payment is intended. If the enclosed bank check were valid for a merchant that was not associated with the gift certificate on the exterior, then the merchant would be under no obligation to honor said gift certificate, again making it worthless.” Office Action, pages 4-5.

Here, the Office uses hindsight in conjunction with official notice to allege that Applicant's claimed invention would be obvious. In rejecting claim 3, from which this claim depends, the Office uses an example of a mailing in a commercial activity in which payment is being remitted to a merchant. Under the Office's subsequent assumptions and interpretations with respect to claim 5, the Office alleges that it is well known that when sending payment to a merchant, the envelope includes a gift certificate on the exterior that is for a discount associated with the merchant. To the contrary, Applicant respectfully submits that it is not well known for such a mailing to include the gift certificate. As a result, Applicant respectfully requests withdrawal of the rejection of claims 5 and 13 as allegedly being obvious in view of Purcell. In the alternative, Applicant respectfully requests that the Office produce some authority for its "official notice".

With respect to claims 7 and 15, the Office takes official notice of the claimed feature that a premature removal of at least one removably perforated tab on a sealed envelope voids a redeemable instrument printed on an exterior side of the sealed envelope. To this extent, the Office states that "it was well known in the art... that there are many ways in which promotional coupons or gift certificates... could be voided if certain procedures were not followed." Office Action, page 5. The Office then describes a coupon being voided when it is removed from a cellular phone bill. *Id.* Applicant contests that such a voiding procedure was well known at the time of the invention. As a result, Applicant respectfully requests withdrawal of the rejection of claims 7 and 15 as allegedly being obvious in view of Purcell. In the alternative, Applicant respectfully requests that the Office produce some authority for its "official notice".

With further respect to claims 7 and 15, even if, *arguendo*, such a procedure was known, it fails to teach or suggest the claimed invention. In particular, in the claimed invention, the

redeemable instrument is voided based on a premature action taken with respect to a sealed envelope. As a result, contrary to the Office's voiding scenario in which a coupon is removed from a cellular phone bill, in the claimed invention no action need be taken with respect to the redeemable instrument to void the redeemable instrument. Further, in the Office's scenario, no action is taken with respect to a sealed envelope, rather action is taken with respect to bill, which is unrelated to a sealed envelope. Still further, the procedure described by the Office goes against the express teachings of Purcell, in which the coupon is intended to be removed in order to be used by an individual. Purcell, col. 1, lines 22-24; col. 1, lines 41-42. As a result, Applicant respectfully requests withdrawal of the rejection of claims 7 and 15 as allegedly being obvious in view of Purcell.

With respect to claims 10 and 18, the Office takes official notice of the claimed feature that the sealed envelope includes a listing of participating merchants on a second exterior side. To this extent, the Office states that it "would have been obvious to provide such a feature because gift certificates often involve multiple merchants and a customer would need to know which merchants they can contact in order to redeem the value of said gift certificate. If a listing were not present, the customer could attempt to redeem the coupon at a non-participating merchant and be rejected and therefore wasting time." Office Action, pages 5-6. However, Applicant respectfully submits that it is not well known to include a listing of participating merchants on a second exterior side of a sealed envelope. As a result, Applicant respectfully requests withdrawal of the rejection of claims 10 and 18 as allegedly being obvious in view of Purcell. In the alternative, Applicant respectfully requests that the Office produce some authority for its "official notice".

With further respect to claims 10 and 18, the Office's official notice goes against the express teachings of Purcell. In particular, in Purcell, the envelope is used in a mailing. Purcell, col. 1, lines 12-14; col. 1, lines 25-26; col. 1, lines 55-67. To this extent, Applicant respectfully submits that a sealed envelope that includes a redeemable instrument printed on a first exterior side and a listing of participating merchants on a second exterior side cannot practically be used in a mailing since neither side of the envelope would include only a destination address, return address, and postage for processing the mailing. As a result, Applicant respectfully requests withdrawal of the rejection of claims 10 and 18 as allegedly being obvious in view of Purcell.

With respect to claim 19, as discussed in the telephone interview, Applicant respectfully submits that the Office fails to show that Purcell teaches or suggests all of the claimed features. For example, in support of its rejection, the Office alleges that Purcell teaches the claimed issuing a redeemable instrument to a first party for a predetermined amount, wherein the redeemable instrument is printed on an exterior side of a sealed envelope, and wherein the sealed envelope contains a negotiable instrument. However, as discussed with reference to claims 3 and 11 above, Purcell teaches "an envelope for first mailing where the bangtail flap includes an external detachable coupon..." (col. 1, lines 35-36). As part of a first mailing, Applicant submits that any type of payment, and therefore a negotiable instrument, is not included. To the contrary, such a payment is included in a second mailing, which uses a different envelope. To this extent, Applicant respectfully submits that Purcell fails to teach or suggest the claimed issuing a redeemable instrument to a first party for a predetermined amount, wherein the redeemable instrument... is printed on an exterior side of a sealed envelope, and wherein the sealed envelope

contains a negotiable instrument. As a result, Applicant respectfully requests withdrawal of the rejection of claim 19 as allegedly being obvious in view of Purcell.

With further respect to claim 19, the Office takes official notice that the claimed reimbursing the second party by allowing the second party to remove the negotiable instrument from the sealed envelope was allegedly well known in the art. In support of this conclusion, the Office states that “cell phone manufacturers often have agreements with service providers to provide discounts to customers whom elect their type of phone.” Office Action, page 7. The Office then describes an apparently hypothetical agreement with various actions performed thereunder, without any evidentiary support that any such agreement has ever existed between any two parties and the corresponding actions have ever been performed by the two parties. Applicant respectfully submits that such an agreement was not well known at the time of the invention. As a result, Applicant respectfully requests withdrawal of the rejection of claim 19 as allegedly being obvious in view of Purcell. In the alternative, Applicant respectfully requests that the Office produce some authority for its “official notice”.

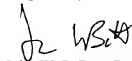
With further respect to claim 19, even if, *arguendo*, such an agreement did exist, the agreement fails to teach or suggest the claimed invention. In particular, the Office describes an agreement in which a “phone service company sends a bill to a customer with a coupon attached for a discount on a certain type of phone from a particular manufacturer. The manufacturer, in exchange for offering the coupon with the bill, would offer some type of benefit to the service provider, such as a royalty payment.” Office Action, page 7. As best understood by Applicant, in the Office’s agreement, the phone service company would allegedly correspond to the claimed third party (since it is sending the coupon), the customer would allegedly correspond to the

claimed first party (since it is receiving the coupon), and the manufacturer would allegedly correspond to the claimed second party. However, under the Office's agreement, neither the manufacturer, nor any of the named parties, is reimbursed by removing a negotiable instrument contained in a sealed envelope with a redeemable instrument printed on an exterior side. As a result, Applicant respectfully requests withdrawal of the rejection of claim 19 as allegedly being obvious in view of Purcell.

Applicant submits that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicant does not acquiesce to the Office's interpretation of the claimed subject matter or the reference used in rejecting the claimed subject matter. Additionally, Applicant does not acquiesce to the Office's modifications of the reference or the motives cited for such modifications. These features and the appropriateness of the Office's modifications have not been separately addressed herein for brevity. However, Applicant reserves the right to present such arguments in a later response should one be necessary.

In light of the above, Applicant respectfully submits that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the number listed below.

Respectfully submitted,

Handwritten signature of John W. LaBatt, consisting of a stylized 'J' and 'L' followed by 'W. LaBatt'.

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